



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/751,025      | 12/31/2003  | Dae Seok Jeong       | 060943-0059         | 3684             |

24341 7590 08/14/2006

MORGAN, LEWIS & BOCKIUS, LLP.  
2 PALO ALTO SQUARE  
3000 EL CAMINO REAL  
PALO ALTO, CA 94306

EXAMINER

VANTERPOOL, LESTER L

ART UNIT PAPER NUMBER

3727

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                      |                 |  |
|------------------------------|----------------------|-----------------|--|
| <b>Office Action Summary</b> | Application No.      | Applicant(s)    |  |
|                              | 10/751,025           | JEONG, DAE SEOK |  |
|                              | Examiner             | Art Unit        |  |
|                              | Lester L. Vanterpool | 3727            |  |

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>June 4, 2004</u> . | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Heideman (U.S. Patent Number 4616771). Heideman discloses the guide grooves (See Figures 2 – 4) provided on both lateral surfaces of the side rail (23) (See Figures 1 – 4); and the mounting (31) (See Figures 3 & 4) slidably engaging the cross rail (41) to the side rail (11) (See Figures 3 & 4), the mounting member (31) (See Figures 3 & 4) comprise the connecting part (42) (See Figures 3 & 4) that is coupled to the cross rail (41) (See Figures 3 & 4) and the locking means (45) that securely fixes movement of the cross rail (41) with respect to the side rail (11) (See Figures 3 & 4).

Regarding claim 2, Heideman further discloses the side rail (11) is formed of the hollow member having closed ends (See Figures 2 – 4), and the center portion of the left and right lateral surfaces (23) are inwardly bent (See Figure 4) and have the cross section of the train rail (See Figures 2 – 4), respectively, to thereby form the guide grooves (See Figures 2 – 4).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3 – 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heideman (U.S. Patent Number 4616771) in view of Kowalski et al., (U.S. Patent Number 4295588). Heideman discloses the invention substantially as claimed.

Heideman discloses the cross rail (41) and the mounting member (31).

However, Heideman does not disclose the cross rail formed of the bar shaped hollow member wherein the engaging part longitudinally extends from the side of the mounting member and is inserted into the interior of the end of the same.

Kowalski et al., teaches the cross rail (40) is formed of the bar shaped hollow member (See Figure 2) wherein the engaging part (48) longitudinally extends from the side of the mounting member (14) and is inserted into the interior of the end of the same (See Figures 1 & 2) for the purpose of providing adequate reliability.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the cross rail formed of the bar shaped hollow member wherein the engaging part longitudinally extends from the side of the mounting member and is inserted into the interior of the end of the same as taught by Kowalski et al., with the vehicle roof rack assembly of Heideman in order to enhance reliability.

Regarding claim 4, Heideman discloses the inner mounting member (31) (See Figure 3) supported by the lateral surface (23) (See Figures 2 – 4) and the upper surface including the inner side guide groove (See Figure 4) of the side rail (11) and having the locking means (45) and the engagement part (See Figures 3 & 4); and the outer mounting member (31) (See Figures 3 & 4) supported by the lateral surfaces (23) (See Figures 2 – 4) and the upper surfaces including the outer side guide groove of the side rail (11) (See Figure 4) wherein the upper side support parts of the members (31) supported on the upper surface of the side rail (11) (See Figures 3 & 4) are engaged with each other by an engaging means (33) (See Figure 3).

Regarding claim 5, Heideman discloses the insertion guide parts (35) inserted in the guide grooves (See Figures 3 & 4) and guided thereby protrude from the side support parts of the members supported on the lateral surfaces (23) of the side rail (11) (See Figure 4).

However, Heideman does not disclose the insertion guide parts inserted in the guide grooves and guided thereby protrude from the lower side support part of the members supported on the lateral surface of the side rail.

It would have been an obvious matter of design choice to make the insertion guide parts inserted in the guide grooves and guided thereby protrude from the lower side support part of the members supported on the lateral surface of the side rail, since applicant has not disclosed that the insertion guide parts inserted in the guide grooves

Art Unit: 3727

and guided thereby protrude from the lower side support part of the members supported on the lateral surface of the side rail solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the insertion guide parts (35) inserted in the guide grooves (See Figures 3 & 4) and guided thereby protrude from the side support parts of the members supported on the lateral surfaces of the side rail (11) (See Figure 4) as taught by Heideman.

Regarding claim 6, Kowalski et al., further discloses the engaging means (50 & 150) is the screw (See Figures 1 – 4) capable of engaging the upper side support parts of the members in the state that they are overlapped (See Figures 1 – 4) for the purpose of providing adequate reliability.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the engaging means the screw capable of engaging the upper side support parts of the members in the state that they are overlapped as taught by Kowalski et al., with the vehicle roof rack assembly of Heideman in order to enhance adequate anchoring reliability.

Regarding claim 7, Kowalski et al., further discloses the locking means (50 & 150) is the bolt (52 & 152) (See Figures 1 – 4) engaged through the bolt hole (54 & 154) of the mounting member (14 & 114) so that the body end locks the guide groove inner surface (See Column 4, lines 11 – 13 & Column 5, lines 31 - 34) (See Figures 1 – 4) for the purpose of providing durable anchoring.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the locking means the bolt engaged through the bolt hole of the mounting member so that the body end locks the guide groove inner surface as taught by Kowalski et al., with the vehicle roof rack assembly of Heideman in order to enhance anchoring durability.

Regarding claim 8, Heideman discloses the first and second side rails (11) (See Figures 2 – 4) configured to install on the vehicle roof panel (10) (See Figure 1) in the longitudinal direction (See Figures 1, 6 & 7); mounting members (31) (See Figure 3) configured to be received around the top surface of each side rail (11) (See Figure 3) with inward lateral (23) projections (See Figures 2 – 4) received in each of the inner and outer guide grooves (See Figure 4); the locking means (45) (See Figures 3 & 4) extending therethrough to contact with its associated guide groove (See Column 7, lines 3 – 13).

However, Heideman does not disclose one of the projection is shorter in length and the mounting member each further having inward projection engaging parts; and at least one cross rail configured to be received on the engaging parts and extending between the mounting members received on the side rails.

It would have been an obvious matter of design choice to make one of the projections shorter in length, since applicant has not disclosed that one of the projection being shorter in length solves any stated problem or is for any particular purpose and it

Art Unit: 3727

appears that the invention would perform equally well with two even projection length as taught by Heideman.

Kowalski et al., teaches having the mounting member (14) each further having inward projection engaging parts (46) (See Column 3, line 55) (See Figure 1 & 2); and at least one cross rail (40) configured to be received on the engaging parts (38) and extending between the mounting member (14) received on the side rails (10) (See Figure 1) for the purpose of providing reliable security anchoring.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the mounting member each further having inward projection engaging parts; and at least one cross rail configured to be received on the engaging parts and extending between the mounting members received on the side rails as taught by Kowalski et al., with the vehicle roof rack assembly of Heideman in order to enhance reliable security anchoring.

### ***Conclusion***

Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the



Art Unit: 3727

claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lester L. Vanterpool whose telephone number is 571-272-8028. The examiner can normally be reached on Monday - Friday (8:30 - 5:00) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3727

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



LLV  
August 9, 2006



JES F. PASCUA  
PRIMARY EXAMINER